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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,485	09/27/2001	John M. Smith III	2250-013	3741

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EXAMINER	
SINGH, ARTI R	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,485	SMITH ET AL.	
	Examiner	Art Unit	
	Ms. Arti Singh	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-41 is/are pending in the application.

4a) Of the above claim(s) 22-41 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to flame resistant textile, classified in class 442, subclass 59+.

II. Claims 22-41, drawn to the method for finishing a flame resistant textile, classified in class 427 in various subclasses. The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the finishing could be co extruded with the fabric and then heat set with rollers to attain the same composite.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Howard MacCord on 08/04/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The uses of Trademarks/Tradenames have been noted throughout this application. The specific name/mark should be in ALL CAPS, followed by either a trademark or copyright symbol and be accompanied by the generic terminology. Although the use of Trademarks/Tradenames is permissible in patent applications, the proprietary nature of the marks/names should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as a trademark or tradename. To describe physical or other properties of material by mere use of trademark is objectionable since it has tendency to make trademark descriptive of product rather than leaving trademark to serve its traditional purpose, which is to identify product's source of origin.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 7, 10, 17 and 18 are indefinite for the use of tradenames in the claims. Where a trademark or tradename is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 USC 112 2nd paragraph. ***See Ex Parte Simpson, 218 USPQ 1020.*** The claim scope is uncertain since the trademark or tradename cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, and 5-14 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6265920 issued to Rubin et al.

11. Rubin et al disclose a liquid and stain resistant antimicrobial fabric that can withstand high temperatures required for transfer printing. A coating composition comprising a copolymer composition, an antimicrobial agent and a fluorochemical composition is applied to a fabric such as polyester (column 3, line 16; column 6, line 30), to produce a coated fabric (abstract). The antimicrobial agent as described in columns 4 and 5, disclose several examples one of which is an organosilicon. The fluorochemical textile-treating agent provides water (fluid) and stain resistance and also list a plethora of known agents in column 5, lines 9-22.

12. Claims 2, 4, 15-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6265920 issued to Rubin et al. Rubin et al teach what is set forth above, but are not specific to the use of phosphonate as the flame retardant and the NFPA 701-1966 test standards.

Given that Rubin et al. meet each and every chemical and structural requirement set forth in the claims, then it must meet the property limitations when tested against the NFPA 701-1996 standards that are recited and would in turn depend from said requirements. In other words, it is reasonable to presume that the invention of Rubin et al. et al. would inherently anticipate the physical properties of the present invention, since both inventions are comprised of coated polyester fabrics having the end use, same antimicrobial agents and fluid repellant applied to them. Furthermore, as no other structural or chemical features are claimed which may distinguish the present invention from that of the Rubin et al. invention, the presently claimed properties of flame resistance are deemed to be inherent to the

invention of Rubin et al. The burden is upon Applicant to prove otherwise. Note *In re Fitzgerald 205 USPQ 495*. In addition, the presently claimed property of flame resistance would obviously have been present once the Rubin et al. product was provided. Note *In re Best, 195 USPQ 433, footnote 4 (CCPA 1977)*. Additionally, Rubin et al disclose that their treated fabrics to be non-flammable under a California 117 E standard, and uses these coated fabrics as upholstery (column 5, line 21), boat covers (column 6, line 61), and drapery (column 3, line 26).

With regard to the limitations desiring the phosphonate, it is the Examiner's position that substituting a known flame retardant for another well known flame retardant is well within the level of one skilled in the art and a skilled artisan would be motivated to use the specific phosphonate as it is readily available.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 703-305-0291. The examiner can normally be reached on M-F 9-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Ms. Arti Singh
Patent Examiner
Art Unit 1771